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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,596	01/30/2001	Mark R. Bennett	END9-2000-0188US1	2376

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HOFFMAN WARNICK & D'ALESSANDRO, LLC  
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EXAMINER
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ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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10/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/772,596

**Applicant(s)**

BENNETT ET AL.

**Examiner**

William J. Allen

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-11, 14, 16-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-11, 14, 16-23, and 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History***

Claims 1-2, 4-11, 14, 16-23, and 25-31 are pending and rejected as set forth below.

### ***Response to Arguments***

Applicant's arguments, see pages 14-15 of Applicant's remarks filed 8/21/2007, with respect to the rejection(s) of claim(s) 1-2, 4-11, 14, 16-23, and 25-31 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Church, Walker, and Cornelius.

Additionally, the Examiner notes that the teaching-suggestion-motivation test is no longer the sole test of obviousness and further notes that, when references unite old elements with no change in their respective function and yield predictable results, the claimed subject matter is obvious under KSR [See *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-2, 4-11, 14, 16-23, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Church et al (US 5794234) in view of Walker (US 5794207).**

**Regarding claim 11, Church teaches:**

*receiving on an information exchange system a transaction element from a first trading partner intended for a second trading partner specified by the first trading partner (see at least: abstract, Fig. 6-7);*

*translating the transaction element from a proprietary schema of the first trading partner in to a universal schema and from the universal schema into a proprietary schema of the second trading partner (see at least: abstract, col. 3 line 60-col. 4 line 2)*

*wherein translation of the transaction element includes translating a data format and an application format of the transaction element (see at least: col. 3 lines 60-63, col. 4 lines 6-14, col. 7 lines 37-40); Note: output data files contain transaction type data (i.e. data format) and the conversion files are tailored for particular database formats (i.e. application format) associated with the accounting system;*

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*routing the transaction element from the first trading partner in a first communication protocol to the second trading partner in a second different communication protocol (see at least: col. 2 lines 46-51, col. 4 lines 32-37);*

*sending a response transaction element from the second trading partner to the information exchange system and routing the response transaction element to the first automotive trading partner (see at least: col. 2 lines 46-51, col. 4 lines 32-37, col. 13 lines 34-41); Note: the network routes incoming and outgoing transmissions to and from the appropriate client computers;*

*mapping the transaction element and the response transaction element with a mapping system, wherein the mapping comprises identifying the first trading partner, the second trading partner, and an application to which the transaction element corresponds (see at least: col. 12 lines 38-54, col. 13 lines 34-41);*

*managing the transaction element and the response transaction element with a mapping system, wherein the managing step comprises tracking a status of the transaction element and the response transaction element (see at least: col. 13 lines 28-31);*

*securing the information exchange system with a security system (see at least: col. 7 lines 27-32).*

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Though Church teaches all of the above as noted, Church does not teach where the information exchange system is an *automotive exchange system* and the trading partners are *automotive*.

Walker teaches a system using EDI for creation and exchange of conditional purchase offers (see at least: abstract, col. 5 lines 25-45). Walker further teaches where a buyer and supplier are a purchaser seeking to procure a car, find car repair services, or provide car rental services (see at least: col. 10 lines 44-46, col. 2 lines 28-33 and 37-38, col. 16 line 6, and Fig. 5 #'s 5 15 and 535).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Church to have included an automotive exchange system and automotive trading partners as taught by Walker in order to facilitate buyer drive4n commerce by allowing buyers to submit customized conditional purchase orders for desired products and services such as automotive services (see at least: Walker, abstract).

Though Church and Walker teach the implementation of a secure network, it is not clear in either that such security measures include *a firewall for controlling access to the computer system*.

In the field of electronic negotiations, Cornelius teaches a buyer and seller negotiating terms of a trade utilizing electronic forms over a network (see at least: abstract). More specifically, Cornelius teaches *a firewall for controlling access to the computer system* (see at least: see at least: col. 24 lines 27-32, col. 77 lines 4-8, col. 169 line 65-col. 170 line 2, Fig. 111 #11110). It

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would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Church to have included where the secure network included *a firewall for controlling access to the computer system* as taught by Cornelius in order to provide a secure system that protects against theft, loss, or misuse of important data on the secure network (see at least: col. 77 lines 4-8).

**Regarding claim 14**, Church in view of Walker teaches *translating the response transaction element from the second proprietary schema to the universal schema and then from the universal schema to the first proprietary schema* (see at least: Church, col. 2 lines 46-51, col. 4 lines 32-37, col. 13 lines 34-41; Walker, col. 5 lines 25-45). Note: the network routes incoming and outgoing transmissions to and from the appropriate client computers.

**Regarding claim 16**, Church in view of Walker in view of Cornelius teaches *wherein the first and second automotive trading partners are selected from the group consisting of: an automotive manufacturer, an automotive parts locator, an automotive parts supplier, an automotive lending provider, a credit reporter, a motor vehicle department, an automotive insurance provider, and an automotive consumer facilitator* (see at least: Walker, col. 10 lines 44-46, col. 2 lines 28-33 and 37-38, col. 16 line 6, and Fig. 5 #'s 515 and 535).

**Regarding claim 17**, Church in view of Walker in view of Cornelius teaches *wherein the transaction element and the response transaction element pertain to an automotive application selected from the group consisting of: automotive parts, automotive sales,*

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*automotive service, automotive insurance, automotive registration, automotive financing, automotive warranty, and credit reporting* (see at least: Walker, col. 10 lines 44-46, col. 2 lines 28-33 and 37-38, col. 16 line 6, and Fig. 5 #'s 515 and 535).

The Examiner notes that claims 1-2 and 4-10, 18-23 and 25, and 26-31 closely parallel and are encompassed by claims 11, 14, 16, and 17. Claims 1-2 and 4-10, 18-23 and 25, and 26-31 are thereby rejected for at least the reasons above.



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***Conclusion***

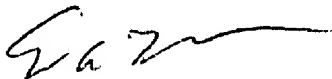
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443.

The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen  
Patent Examiner  
October 3, 2007



Mark Fadok

Primary Examiner